



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,769	12/27/2001	Shuang Liu	DM-6950	9943

46339 7590 04/20/2006

BRISTOL - MYERS SQUIBB COMPANY
PATENT DEPARTMENT
PO BOX 4000
PRINCETON, NJ 08543-4000

EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,769

Applicant(s)

LIU, SHUANG

Examiner

D. L. Jones

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,15,17-22,27,29-34,39,41-46 and 66-87 is/are pending in the application.
4a) Of the above claim(s) 29-34 and 41-46 is/are withdrawn from consideration.
5) ☒ Claim(s) 1, 3-9, 15, 17-22, 27, 39, and 66-86 (in part) is/are allowed.
6) ☒ Claim(s) 87 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/1/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the acceptable RCE (request for continuing examination) filed 2/1/06. In addition, the Examiner acknowledges the amendment filed 2/1/06 wherein claims 2, 10-14, 16, 23-26, 28, 35-38, 40, 47-65, and 88-110 are canceled and claim 87 is amended.

Note: Claims 1, 3-9, 15, 17-22, 27, 29-34, 39, 41-46, and 66-87 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

2. The Applicant's arguments/amendment filed 2/1/06 to the rejection of claim 87 made by the Examiner under 35 USC 102 has been fully considered and deemed persuasive because Applicant has amended the claim to overcome the rejection. Therefore, the said rejection is hereby withdrawn.

WITHDRAWN CLAIMS

3. Claims 29-34 and 41-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

NEW GROUNDS OF REJECTION (102 Rejection)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

Art Unit: 1618

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 87 is rejected under 35 U.S.C. 102(e) as being anticipated by Schroder et al (US Patent No. 6,153,775).

Schroder et al disclose polydentate imines and their metal complexes (see entire documents, especially, abstract). In particular, Schroder et al disclose Scheme 1 (column 15) wherein one of the reactants fulfill the limitations of claim 87 when A = nitrogen; K = 2, and both R17 and R18 = hydrogen. Thus, both Applicant and Schroder et al disclose overlapping compounds.

ALLOWABLE CLAIMS

7. Claims 1, 3-9, 15, 17-22, 27, 39, and 66-86 are allowable over Applicant's elected species and the species represented as EXP#1 in the office action mailed 7/29/03.

Elected species: the chelant is tripodal; the spacer, A, is N; E1, E2, and E3 are $(CH_2)_k-NHCOCH_2N(CH_2COOH)_2$; and the radionuclide is ^{90}Y .

Art Unit: 1618

EXP #1: A = R1-C, R1-Si, R1-Ge, N, P, and P(O); k = 0 – 3;

E1, E2, and E3 = (CR17R18)k-Z-X-(CR19R20)NR21R22;

Z = bond, O, NH, NR1NR1, ONH, N(OR1); X = P(O)(OR1);

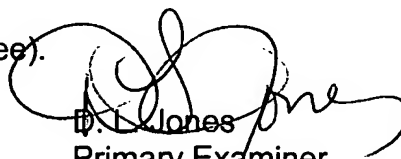
l = 1 – 3; and R1 and R17-R22 are as set forth in the claims.

Note: It should be noted that the full scope of all the pending claims has not been searched since prior art has been found to reject the claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
Art Unit 1618

April 17, 2006